

REMARKS

This Reply is in response to the Office Action mailed on November 3, 2006 in which Claims 1-8, 10-16, 18-23 and 25-35 were rejected. For the reasons which follow, the rejection of claims 1-8, 10-16, 18-23 and 25-35 should be withdrawn. Accordingly, Applicants respectfully request reconsideration and allowance of the present application.

I. Rejection of Claims 1-8, 10-16, 18-23 and 25-35 Under 35 U.S.C. § 102(e) Based Upon Chang.

Pages 2-6 of the Office Action rejected Claims 1-8, 10-16, 18-23 and 25-35 Under 35 U.S.C. § 102(e) as being anticipated by Chang et al. US Patent Publication 2002/0059415. For the reasons which follow, the rejection of claims 1-8, 10-16, 18-23 and 25-35 based upon Chang should be withdrawn.

A. Claim 1

Claim 1 recites a method of configuring a hard copy output engine. The method includes receiving an electronic message including hard copy output engine configuration data from an undesignated web site through a firewall and configuring the hard copy output engine using the configuration data. The data transmitted through the firewall designates a hard copy output engine to be configured.

Chang fails to disclose a method which includes receiving an electronic message including hard copy output engine configuration data from an undesignated website through a firewall and configuring the hard copy output engine using the configuration data. In contrast, Chang discloses a method wherein printer driver components are uploaded from an output controller 120, which is integrated within output device 140 (i.e., the printer, see [0094]) or which is provided in a separate box connected to the output device 140 (see Paragraph [0075]), to information apparatus 100 (i.e., the PC; see [0043]). Nowhere does Chang disclose receiving an electronic message including hard copy output engine configuration

data. Nowhere does Chang disclose receiving such an electronic message from an undesignated website through a firewall.

In rejecting claim 1, the Office Action attempts to rely on Paragraph [0197] and Figures 8a-g of Chang as allegedly disclosing the reception of an electronic message including hard copy output engine configuration data from an undesignated website three firewall. However, such portions of Chang do not even remotely disclose such limitations. Paragraph [0197] of Chang simply discloses the reception of an e-mail by information apparatus 100 (i.e., the PC). Nowhere does Paragraph [0197] disclose that the e-mail includes hard copy output engine configuration data.

With regard to Figures 8a-8g, such figures merely illustrate the process of Chang wherein a printer driver is uploaded to information manager 100 (i.e. a PC) from output controller 120 which is part of the printer or which is contained in a box connected to the printer. (See [Paragraph 023]. The assertion that the recited "uploading" somehow meets the claim limitation "receiving an electronic message including hard copy output engine configuration data from an undesignated website every firewall" lacks merit and completely contradicts the entirety of Chang. The disclosure of Chang is replete with citations clearly indicating that the "uploading" is from output controller 120 (part of or connected to a printer) to information manager 100 (the PC). (e.g. See Paragraphs [0055], [0062], [0067], [0075] [0080], [0082], [0084], [0160]).

Moreover, even assuming, *arguendo*, that such "uploading" was somehow from an undesignated website through a firewall, nowhere does Chang disclose hardcopy output engine configuration data included with an electronic message. Accordingly, rejection of claim 1 is improper and should be withdrawn. Claims 2-7 depend from claim 1 and overcome the rejection for the same reasons.

B. Claims 2, 8, 15, 20, 22 and 35

Claims 2, 8, 15, 20, 22 and 35 each recite configuring the hardcopy output engine via an embedded web server contained in the hardcopy output engine using the configuration data.

Chang fails to disclose configuring a hardcopy output engine via an embedded Web server contained in the hardcopy output engine using the configuration data. In contrast, Chang merely discloses output device 140. Chang does not appear to disclose that output device 140 includes an embedded Web server.

In rejecting claim 2, the Office Action assert that Chang discloses an embedded Web server and refers to Figure 3, element 302, by noting that "Internet browsing application corresponding to embedded Web server contained in the apparatus 100)."

However, Applicants respectfully note that element 302 in Figure 3 is not part of output device 140 (the printer). In contrast, e-mail application 302 is part of information apparatus 100 which is described by Chang as a PC or similar device. Figure 1 of Chang makes clear that information apparatus 100 is not a printer. Thus, Chang does not disclose a printer or hardcopy output engine having an embedded Web server. Thus, the rejection of claims 2, 8, 15, 20, 22 and 35 based upon Chang should be withdrawn. Claims 10-13 depend from claim 8 and overcome the rejection for the same reasons.

C. Claims 4, 11, 14, 21 and 29

Claims 4, 11, 14, 21 and 29 each recite receiving an e-mail including hardcopy output engine configuration data or configuration signals through the firewall at a first user station or transmitting the electronic message to a user station (claim 29) and further forwarding the e-mail or electronic message to the hardcopy output engine.

As noted above with respect to the rejection of claim 1, Chang fails to disclose any receipt of an electronic message including hardcopy output engine configuration data or signals that cause such configuration. Moreover, Chang also fails to disclose receiving such an e-mail and forwarding such an e-mail to a hardcopy output engine.

In rejecting such claims, the Office Action assert that Chang discloses forwarding the e-mail to the hardcopy output engine and refers to Paragraph [0201]. However, Paragraph [0201] says nothing about forwarding an e-mail to a printer or hardcopy output engine. Paragraph [0201] says nothing about forwarding an e-mail including hardcopy output engine configuration data to output device 140. Thus, the rejection of claims 4, 11, 14, 21 and 29 is improper and should be withdrawn. Claims 15-16 and 18-20 depend from claim 14 and overcome the rejection for the same reasons. Claims 22-23 and a 25-26 depend from claim 21 and overcome the rejection for the same reasons.

D. Claims 5, 12, 20 and 25

Claims 5, 12, 20 and 25 each recite that the hardcopy output engine is configured via an embedded web server to set a threshold for an element chosen from a group consisting of: pigmentation material, number of hours of operation and number of sheets of print media consumed.

Chang fails to disclose a hardcopy output engine configured via an embedded Web server that set a threshold for an element chosen from a group consisting of pigmentation material, number of hours of operation and number of sheets of print media consumed. As noted above, Chang does not even disclose a hardcopy output engine having an embedded web server. Chang does not disclose configuring a hardcopy output engine using an embedded web server. Moreover, Chang does not disclose such configuring including the setting of the recited thresholds.

In rejecting claim 5, Section 6 of the Office Action asserts:

Regarding claim 5, Chang further discloses the method of claim 1, wherein receiving the electronic message comprises receiving an XML script (Chang, [0101]), and configuring include setting a threshold for an element chosen from a group consisting of: pigmentation material, marking material, number of hours of operation and number of sheets of print media consumed (Chang, [0202] l.9-10, i.e. the estimation of time of operation, and [0204]).

(Office Action, pg. 4).

However, the Office Actions characterization of what is taught by Chang is incorrect. First, Paragraph [0101] of Chang merely discloses the language of the print data sent from information apparatus 102 output device 140. Nowhere does Paragraph [0101] describe that an electronic message includes the XML script.

Second, Chang does not disclose setting a threshold which includes an element chosen from the claimed group. Chang does not disclose setting a threshold for the number of hours of operation of the hardcopy output engine. The Office Action points to Paragraph [0202]. However, Paragraph [0202] merely discloses that information apparatus 100 may provide to the user "the estimation of time needed for the uploading." The mere act of displaying the time estimated for uploading (1) is not an act of setting a threshold for a hardcopy output engine and (2) is not setting a threshold for the number of hours of operation of a hardcopy output engine.

With regard to Paragraph [0204] pointed to by the Office Action, Applicants respectfully note that the noted parameters are set by the user using screen 840. These parameters are not disclosed by Chang as being provided with an electronic message. These parameters are not disclosed as being set during configuring of the hardcopy output engine based on instructions contained in an electronic message. Thus, the rejection of claims 5, 12, 20 and 25 is improper and should be withdrawn

F. Claim 27

Claim 27 recites a method which includes a step of forming hardcopy output engine configuration data on a first side of the firewall based upon input received from a second side of the firewall and transmitting an electronic message including the configuration data through the firewall to a hardcopy output engine on the second side of the firewall.

Chang fails to disclose configuring a hardcopy output engine using configuration data received as part of an electronic message. As a result, Chang does not disclose forming hardcopy output engine configuration data on a first side of the firewall based on input received from a second side of the firewall, the second side of the firewall being the same side of the firewall that includes the hardcopy output engine. Accordingly, the rejection of claim 27 is improper and should be withdrawn. Claims 28-35 depend from claim 27 and are patentably distinct over Chang for the same reasons.

G. Claim 31

Claim 31 depends from claim 27 and further recites the step of transmitting an electronic message including an address of the hardcopy output engine from the second side of the firewall (i.e., the same side of the firewall that contains the hardcopy output engine) to the first side of the firewall.

Chang fails to disclose this step. In fact, the Office Action fails to establish even a prima facie case of anticipation in that the Office Action fails to address the limitations of claim 31 which are not found in claims to relate and 10-13. Thus, the rejection of claim 31 is improper and should be withdrawn for this additional reason.

H. Claim 34

Claim 34 depends from claimed 27 and further recites that providing the input comprises interacting with a web site on the first side of the firewall with a web browser on the second side in the firewall (the same side of the firewall as the hardcopy output engine).

Chang fails to disclose providing input to a web site on the first out of the firewall using a web browser on the same side of the firewall as the hardcopy output engine. Chang also fails to disclose and hardcopy output engine that receives configuration data via an electronic message, wherein configuration data is formed based upon such input. Thus, the rejection of claim 34 is improper and should be withdrawn for this additional reason.

III. Conclusion.

Claims 1-8, 10-16, 18-23 and 25-35 are now pending in this application.

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 08-2025. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 08-2025. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 08-2025.

Respectfully submitted,

Date Jan. 30, 2007

By Todd A. Rathe

RATHE PATENT & IP LAW
Customer No. 22879
Telephone: (262) 478-9353
Facsimile: (262) 238-1469

Todd A. Rathe
Attorney for Applicant
Registration No. 38,276